

PATENT
Atty. Dkt. No. ROC920010109US1
MPS Ref. No.: IBMK10109

REMARKS

This is intended as a full and complete response to the Office Action dated May 24, 2005, having a shortened statutory period for response set to expire on August 24, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-46 are pending in the application. Claims 1-46 remain pending following entry of this response. Claims 15, 16 and 46 have been amended. Applicants submit that the amendments do not introduce new matter and do not raise new issues.

Claim Rejections - 35 U.S.C. § 103

Claims 1-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Jong et al.* (US 6,192,403, hereinafter *Jong*) in view of *Malik* (US 6,618,370 B1).

The Examiner takes the position that

"[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the system solution based on the usage trend as taught by Malik into the system of Jong because it would improve the performance of the system by monitoring and allowing a user to view the amount of usage and the performance analysis for the computer system."

Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the first and third criteria.

To rely on a reference under 35 U.S.C. § 103, the reference must be analogous prior art. See MPEP § 2141.01(a). A reference is considered analogous prior art if the reference is either in the field of Applicants' endeavor or, if the reference is reasonably pertinent to the particular problem with which the inventor was concerned. *Id.* A

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reference is pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. See *id.*, citing *Wang Laboratories v. Toshiba Corp.*, 993 F.2d 858 (Fed. Cir. 1993). Furthermore, when determining whether a reference is analogous, the Examiner cannot look at isolated teachings of the prior art without considering the over-all context within which those teachings are presented. *In re Pagliaro*, 657 F.2d 1219, 1225 (Cust & Pat.App., 1981). Thus, the Examiner must consider each reference as a whole and determine if the reference as a whole is concerned with problems associated with the pending application. *Id.*

Applicants submit that the *Malik* reference, as a whole, is not concerned with the problems associated with the pending application and is not in the field of Applicant's endeavor. *Malik* discloses a system and method which allow an Internet Service Provider (ISP) to dynamically expand the number of telephone lines and modems available to ISP subscribers dialing into the ISP system. The system disclosed by *Malik* re-directs calls from a subscriber to an ISP from the ISP's modem pools to a shared modem pool operated by a telephone service provider when the ISP needs additional bandwidth. In contrast, the pending application is concerned with providing recommendations of computer system upgrades. Therefore, Applicants submit that the *Malik* reference is not an analogous art and may not be relied upon as a reference under 35 U.S.C. § 103.

Furthermore, even assuming, purely for the sake of argument, that *Malik* qualifies as analogous art, the prior art references, when combined, do not teach or suggest all the claim limitations.

Jong discloses an adaptive monitor/support system which adapts the monitoring processes for a monitored device based on respective device usages. The monitor/support system, as disclosed in *Jong*, downloads special monitor and/or support programs or instructions to change the monitoring process, *i.e.*, the downloads are directed only to the monitoring/support program. The portions of *Jong* cited by the Examiner are all directed to a monitoring/support program which may change its monitoring process based on usage trends.

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The portion of *Malik* cited by the Examiner are directed to data regarding the number of subscribers from each ISP which may "help ISPs identify usage trends and could be used to project future requirements for subscriber support." (*Malik*, Col 5, line 58 to Col. 6, line3).

However, the references cited by the Examiner, either alone or in combination, do not teach, show or suggest providing recommendations of computer system upgrades. More particularly, the references do not teach, show or suggest a method or system which determines projected requirements for at least one computer system solution based on the usage trend for the computer. Furthermore, the references do not teach, show or suggest a method or system which generates a recommendation for the at least one computer system solution which satisfies at least the projected requirements. At most, the references cited by the Examiner provide a monitoring/support program which may change its monitoring process based on usage trends and projected requirements for the monitoring process. Even as such, the references do not teach, show or suggest methods or systems for providing a recommendation for a computer system solution as claimed.

Regarding the dependent claims, Applicants submit that the references cited by the Examiner do not teach, show or suggest features recited in the dependent claims. For instance, the references do not teach, show or suggest allowing a user to modify the recommendation. The references do not teach, show or suggest configuring a system and indicating the system specifications and price. The references do not teach, show or suggest configuring system/options and/or receiving a purchase order for the recommended computer system solution. In conclusion, the references do not teach, show or suggest a method or system for providing recommendations satisfying projected requirements, configuring recommended systems, and/or purchasing system upgrades/options as claimed.


Accordingly, the claims are believed to be allowable, and Applicants respectfully request withdrawal of the rejection.

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Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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